

The Examiner has rejected claims 1-47 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-60 of Sumner *et al.*, U.S. Patent No. 6,159,347 (hereinafter, US-'347), and claims 1-67 of Sumner *et al.*, U.S. Patent No. 6,224,717 (hereinafter, US-'717).

I. Rejection Under § 102(f)

Accompanying this Reply is a Declaration under 37 C.F.R. § 1.132 executed by Charles E. Sumner, Jr., declaring that Charles E. Sumner, Jr. is the sole inventor of the claimed invention of the present application.

Thus, Applicant respectfully requests that this rejection be withdrawn.

II. Rejection Under Obviousness-Type Double Patenting

Applicant respectfully submits that the Examiner did not address the issues set forth in Applicant's Reply dated April 11, 2002. The Applicant respectfully requests that the Examiner consider the following argument, withdraw the obviousness-type double patenting rejection, and initiate an interference between the present application and US-'347 and US-'717.

A. Statement of Facts

In support of Applicant's argument, the following facts are set forth:

- i) that the present application was filed as a CPA after November 29, 1999.

ii) that US-'347 and US-'717 lists as inventors, Charles E. Sumner, Jr., John D. Moncier, Jeffrey S. Kanel and Mary K. Foster, and that the sole inventor of the present application is Charles E. Sumner, Jr.; US-'347 and US-'717 qualify as subject matter developed by 'another' because the claimed invention of the present application was made by a different inventive entity with at least one inventor in common with US-'347 and US-'717 (*see* MPEP § 2137.01).

iii) that the present application has been rejected under 35 U.S.C. § 102 only under subsection (f) for which Applicant has provided a *Katz* declaration (*see* above),

iv) that the Applicant provided evidence in accord with MPEP § 706.02(1)(2) in the Reply dated January 3, 2002 supporting common ownership to Eastman Chemical Company of the subject matter of US-'347 and US-'717 and the claimed invention of the present application at the time of invention, and

v) that the present application is assigned to Archer-Daniels-Midland Co., and that US-'347 and US-'717 are assigned to a different entity, and therefore a terminal disclaimer can not be filed.

B. Argument in Support of Applicant's Position that an Obviousness-Type Double Patenting Rejection is Improper

In view of the facts presented above, the statutory language of 35 U.S.C. § 103(c) and the guidelines set forth in the MPEP, the Applicant respectfully submits that the Examiner has improperly applied an obviousness-type double patenting rejection. Because the present application falls within the provisions of 35 U.S.C. § 103(c), the judicial doctrine of obviousness-type double patenting as applied prior to enactment of 35 U.S.C. § 103(c)

is no longer applicable in this situation. Section 35 U.S.C. § 103(c) is plain and unequivocal in setting forth that the earlier inventions (*i.e.*, US-'347 and US-'717) are disqualified as prior art against the later invention.

The statute reads as follows:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Regarding the applicability of 35 U.S.C. § 103(c), the MPEP states that:

Two inventions of different inventive entities come within the provisions of 35 U.S.C. 103(c) when:

(A) the later invention is not anticipated by the earlier invention under 35 U.S.C. 102;

(B) the earlier invention qualifies as prior art for the purposes of obviousness under 35 U.S.C. 103 against the later invention only under subsection (f) or (g) of 35 U.S.C. 102, or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999; and

(C) the inventions were, at the time the latter invention was made, owned by the same person or subject to an obligation of assignment to the same person.

MPEP § 804.03 II.

Further, regarding the establishment of a basis for obviousness-type double patenting, the MPEP states:

[A]ny analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination.

MPEP § 804 II B (1).

The MPEP makes it clear that an obviousness-type double patenting rejection relies on claimed subject matter in a prior art reference that renders a present claim obvious. The

Examiner reveals that he utilized 35 U.S.C. § 103 guidelines in his analysis and rejection by asserting that the claimed invention of the present application would have been obvious to one of ordinary skill in the art at the time of invention in view of the claimed inventions of US-'347 and US-'717. However, when 35 U.S.C. § 103(c) is properly applied in this situation, US-'347 and US-'717 are statutorily barred from use against the present application. Thus, there is no longer support for the obviousness-type double patenting rejection.

Applicant respectfully requests that this rejection be withdrawn.

III. The Present Application and US-'347 and US-'717 Have the Same Filing Date

Applicant respectfully reminds the Examiner that facts set forth in the record show the present application claims priority to the filing date of US-'347 and US-'717 and was co-pending with US-'347 and US-'717 until their issuance. The Applicant respectfully contends that upon considering these facts, and further understanding this situation involves different inventive entities, no common assignee and interfering subject matter, it is necessary to determine junior and senior priority. Applicant respectfully suggests that the Examiner take steps to institute an **interference** between the present application and US-'347 and US-'717. Applicant further submits that an interference is clearly appropriate for the present claims to be given their proper consideration, on equal footing with formerly co-pending US-'347 and US-'717, and in accord with interference practice.

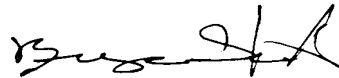
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all currently outstanding rejections and that they be withdrawn. In the alternative, Applicant requests initiation of an interference between the present application and US-'347 and US-'717. Applicant believes that a full and complete reply has been made to the outstanding Office Action. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted.

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Bryan L. Skelton
Agent for Applicant
Registration No. 50,893

Date: October 22, 2002

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600